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09/852,995	05/10/2001	Andrew N. Harker	0585-1026	5818

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EXAMINER

BLACK, LINH

ART UNIT PAPER NUMBER

2167

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

6

## Office Action Summary

Application No.

09/852,995

Applicant(s)

HARKER ET AL.

Examiner

LINH BLACK

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-14, 16-19 and 22-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-14, 16-19, 22-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

This communication is in response to the Amendment dated 6/7/2005. Claims 6, 15, 20-21, and 30-31 have been cancelled.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-2, 10-14, 16-19, 23-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Thro et al. (USP 6147977).

2. Thro et al. anticipated the independent claim 1 by the following:

“a database storing a plurality of entries each relating to a recipient party” – col. 3, lines 48-62.

“each entry being stored according to a unique identifier assigned to the corresponding recipient party” – fig. 2, elements 76-86; col. 5, line 25 to col. 6, line 51.

“at least one rule included in each entry, specifying a manner, of communications between the corresponding recipient party and an initiating party” – fig. 2, elements 76-82; col. 5, line 25 to col. 6, line 51.

“an initiating party interface arranged to cooperate with an initiating party’s communications device to cause a communications application software appropriate to the manner of communications specified in said rule to automatically execute at the initiating party’s device” – col. 4, lines 5-12; col. 8, lines 22-61.

“wherein the system manages communications between an initiating party and a recipient party according to appropriate rule” – col. 3, line 61 to col. 4, line 66.

“and in response to a request from an initiating party to communicate, the server generates data which, when processed at an initiating party device, results in the automatic execution of communications application software” - col. 8, lines 22-61.

3. Thro et al. anticipated claim 2 by the following:

“wherein the presence system comprises a server hosting the database.” – fig. 1, elements 12-14; col. 3, lines 48-63.

Applicants do not explicitly define or show the limitation: “a server hosting a database” in the specification or in Applicants’ figure 1. According to Microsoft Computer Dictionary Fourth Edition, “host” (n) is defined as

- In PC-based networks, a computer that provides access to other computers.

- On the Internet or other large networks, a server computer that has access to other computers on the network.

“host” (v) is defined as

- to provide services to client computers that connects from remote locations.

Thus, examiner interprets the limitation “a server hosting the database” is equivalent to “a server controlling the database’s data and access”.

4. Thro et al. anticipated claim 10 by the following:

“wherein in response to a query from an initiating party, the database returns the unique identifier.” – col. 3, line 62 to col. 4, line 12; col. 4, lines 40-50.

5. Thro et al. anticipated claim 11 by the following:

“wherein in response to a query from an initiating party, the database returns details about a recipient party.” – col. 3, line 62 to col. 4, line 54; col. 5, line 45 to col. 6, line 67.

6. Thro et al. anticipated claim 12 by the following:

the database returns details in accordance with each rule for the querying initiating party – col. 7, line 17 to col. 8, line 21.

7. Thro et al. anticipated claim 13 by the following:

“wherein each entry includes details of each communication device at the disposal of the corresponding recipient party” – fig. 2, elements 76-86; col. 3, lines 33-63; col. 7, line 17-67.

Applicants teach “Many people now have various different communication devices at their disposal, such as, for example, so-called plain old telephone service (POTS) devices, mobile telephone devices, personal computers (PC) and hand-held computers.” – specification, page 1, lines 13-15.

“each rule specifies to which device communications from an initiating party should be directed.” – col. 5, lines 45 to col. 6, line 67; col. 7, lines 1-44.

8. Thro et al. anticipated claim 14 by the following:

“wherein each entry includes details of known initiating parties” - fig. 2, elements 76; col. 3, line 48 to col. 4, line 12; col. 5, lines 25-67 col. 7, lines 1-44.

“and there is at least one rule specified for each known initiating party as well as a default rule for every other initiating party.” – col. 3, line 64 to col. 4, line 12; col. 4, line 46 to col. 5, line 67.

9. Thro et al. anticipated the independent claim 16 by the following:

“assigning a unique identifier to the recipient party” - fig. 2, elements 76-86; col. 5, line 25 to col. 6, line 51.

“making at least one rule specifying the manner of communications between an initiating party and the recipient party” - fig. 2, elements 76-82; col. 5, line 25 to col. 6, line 5.

“causing a communications application software appropriate to the manner of communication specified in said rule to automatically open at an initiating party’s device” – col. 3, lines 32-47; col. 4, lines 5-12; col. 5, lines 11-25; col. 8, lines 35-49.

“wherein the unique identifier is used to direct a request for communications from an initiating party to a system which manages communications between the initiating party and the recipient party by generating data in accordance with each rule processing the data at an initiating party device results in the automatic execution of communications software” - col. 3, line 61 to col. 4, line 66; col. 8, lines 22-61.

10. Thro et al. anticipated claim 17 by the following:

“wherein the initiating party queries the system for the unique identifier” - col. 3, line 62 to col. 4, line 12; col. 4, lines 40-50.

11. Thro et al. anticipated claim 18 by the following:

“wherein the initiating party queries the system using known details of the recipient party” – the abstract; col.2, lines 48-66.

In the specification, Applicants do not explicitly teach the limitation “known detail” of the recipient party. Thus, Examiner interprets “the identity of the receiving party” as “known detail”.

12. Thro et al. anticipated claim 19 by the following:

“wherein the initiating party queries the system for other details of the recipient party” -  
col. 3, line 62 to col. 4, line 54; col. 5, line 45 to col. 6, line 67.

13. Thro et al. anticipated claim 20 by the following:

“wherein communications are managed by generating data” – col. 3, lines 48-63; col. 4,  
lines 46-66; col. 7, lines 35-44.

14. Thro et al. anticipated claim 23 by the following:

“wherein the system comprises a database and the unique identifier is used to locate an  
entry relating to a recipient party contained in the database” – fig. 1, element 14; fig. 2,  
elements 74-86; col. 3, line 48 to col. 4, line 66.

15. Thro et al. anticipated claim 24 by the following:

“wherein the recipient party enters contact details into the entry” – col. 3, line 48 to col.  
4, line 12.

16. Thro et al. anticipated claim 25 by the following:

“wherein the recipient party enters details of the communications devices into the entry”  
- fig. 2, elements 74-86; col. 3, line 48 to col. 4, line 12.

17. Thro et al. anticipated claim 26 by the following:

“wherein the recipient party enters details of known initiating parties into the entry” - fig. 2, elements 76; col. 3, line 48 to col. 4, line 12; col. 5, lines 25-67.

18. Thro et al. anticipated claim 27 by the following:

“wherein the recipient party enters into the entry at least one rule for each known initiating party” - fig. 2, elements 76; col. 3, line 48 to col. 4, line 12; col. 5, lines 25-67; col. 7, lines 1-44.

“and a default rule for every other initiating party.” – col. 3, line 64 to col. 4, line 12; col. 4, line 46 to col. 5, line 67.

19. Thro et al. anticipated the independent claim 31 by the following:

“a plurality of entries each relating to a recipient party” – col. 3, lines 48-62.

“each entry being stored according to a unique identifier assigned to the corresponding recipient party” – fig. 2, elements 76-86; col. 5, line 25 to col. 6, line 51.

“at least one rule included in each entry, specifying which details for the entry may be disclosed to an initiating party” – fig. 2, elements 76-82; col. 3, line 61 to col. 4, line 66; col. 5, line 25 to col. 6, line 51.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 3-9, 22, and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thro et al. (USP 6147977), and further in view of Swartz (USP 6445694).

21. As per claim 3, Thro et al. do not explicitly suggest "wherein interaction between an initialing party and the database is in the manner of interaction with an Internet Web site."

Swartz teaches "The subscriber employs a web interface to populate a database with preference data which is used by the host service processor to handle incoming calls and establish outgoing telephone connections in accordance with the preference data provided by the subscriber... The subscriber may also use the web interface to specify whether call waiting is to be activated, to screen or reroute calls from designated numbers, for recording voice mail messages in designated voice mailboxes, for selectively playing back voice mail messages via the web interface or for forwarding voice mail messages via the web interface or for forwarding voice mail as an email attachment, for handling incoming fax transmissions using character recognition and email attachment functions, and for automatically paging the

subscriber when incoming voice mail, fax, or email messages are received, all in accordance with the web interface.” – the abstract. Swartz also teaches the interaction between an initiating party and the database is in the manner of interaction with an Internet Web site – fig. 5; col. 10, line 37 to col. 12, line 59. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the applicants’ teaching with Swartz’s teaching in order to improve the communication between calling/sending party and receiving party because by taking advantage of the Web Sites which allows preferred or efficient ways of communications to be set up by calling/receiving parties which results in more efficient ways to communicate between parties.

22. As per claim 4, Thro et al. teach: “the server generates a recipient index, which identifies an address for subsequent retrieval of the message content and for optional use as a reference identifier for returning an acknowledgement of understanding t the originator party.” – col. 2, lines 62-66. Thro also teach the usage of different communication devices – fig. 2, element 74: email, pager, phone, and facsimile. Thro et al. do not explicitly suggest “data processable by an Internet enabled device.” Swartz teaches “The arrangement seen in FIG. 1 provides the facilities needed for controlling a variety of communications services, including telephone, email, fax and paging services provided by a host services computer operating under the control of either or both (1) a World Wide Web interface and (2) a telephone interface.” – col. 2, lines 2-7 and lines 55-67, wherein the host services

computer is a server – col. 1, lines 62. Swartz also teaches “the server generates data processable by an Internet enabled device” – col. 3, lines 31-59; col. 10, lines 54-67. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the applicants’ teaching with Swartz’s teaching in order to enable communication devices with Internet access in order to facilitate the interactions and control of users’ communications through a Web interface thus provide better services for the users.

23. As per claims 5 and 28-29, Thro et al. teach “The outputs are generated in the form; time of delivery; device choice; message content (may be filtered/truncated or converted to the appropriate media); message priority relative to other messages bound for current device choice; and message priority relative to all other messages.” – col. 7, lines 39-44; Thus, Thro et al.’s teaching do suggest data conversion module. As Thro et al.’s teaching can convert data to the appropriate media for different communication devices, it is obvious that Thro et al.’s teaching can receive inputs from different communication devices and converts the data to a form where the server can process, which also enables different parties to communicate with each other.

However, Swartz further teaches “To effect email handling, the host services computer operates as a POP mailbox and SMTP server for receiving and sending email respectively. In order to coordinate email, voicemail and fax transmission, the host services computer may advantageously employ a set of

conventional format conversion functions including: voice to text speech recognition for converting voice mail into text form suitable for transmission via email as well as by voice file MIME attachments to email; optical character recognition for translating fax transmissions into text form for email transmission as well as by MIME fax file attachments to email. The information provided on the form of FIG. 8, which is self explanatory, allows email, fax and voice mail messages to be forwarded, stored, and redirected in a variety of ways in response to option selections made by the subscriber as shown. " – col. 12, lines 20-35. Swartz also teaches more of data conversion on col. 13, lines 27-65. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to apply the conversion modules in order to enable Internet enabled devices access and interact with the host service computer or communication server, thus, allow multi-media communications through the web interface and so provide more flexible and better services for the users.

24. As per claims 6 and 21, Thro et al. teach in response to a request from an initiating party to communicate, the server generates data which results in the opening of a communications application." – col. 2, line 48 to col. 3, line 6; col. 6, lines 1-51.

Thro et al. do not explicitly suggest: "when processed at an initiating party device".

Applicants in the specification, page 7, line 23 to page 8, line 3 state that "From information stored within the device 24, 26, 28 the identity of the initiating party 8 is sent to the system 4. The identity is compared with the identities of known initiating parties 8 included in the recipient party's entry. If a known initiating party is

determined, the communication rules applicable to that party are invoked. If the initiating party is unknown, the default rules are invoked. Data is returned to the initiating party's device 24, 26, 28 according to the invoked rules. The data may result in the opening at the initiating party's device 24, 26, 28 of the communications application appropriate to -the manner of communication dictated by the rule." However, applicants do not explicitly define/disclose the limitation "data", for example, which type(s) of data that the server will generate.

Swartz further teaches in response to a request from a subscriber to the server to place a call, a form is displayed at the user' browser which allows the user to enter a phone number to be called or several phone numbers for a conference call which results in the opening of a communication line – col. 7, lines 10-30. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the applicants' teaching with Swartz's teaching in order to improve the communication between calling and receiving parties because by taking advantage of the Web Sites which allows preferred or efficient ways of communications to be set up by calling/receiving parties which results in more efficient ways to communicate between parties.

25. As per claims 7 and 22, Thro et al. teach in response to a request from an initiating party to communicate, the server generates data which results in at least one instruction or notification." – col. 2, line 48 to col. 3, line 47; col. 6, lines 1-51; col. 9,

lines 1-65. Thro et al. do not explicitly suggest: "when processed at an initiating party device".

Applicants in the specification, page 7, line 23 to page 8, line 3 state that "From information stored within the device 24, 26, 28 the identity of the initiating party 8 is sent to the system 4. The identity is compared with the identities of known initiating parties 8 included in the recipient party's entry. If a known initiating party is determined, the communication rules applicable to that party are invoked. If the initiating party is unknown, the default rules are invoked. Data is returned to the initiating party's device 24, 26, 28 according to the invoked rules. The data may result in the opening at the initiating party's device 24, 26, 28 of the communications application appropriate to -the manner of communication dictated by the rule." However, applicants do not explicitly define/disclose the limitation "data", for example, which type(s) of data that the server will generate.

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communications to be set up by calling/receiving parties which results in more efficient ways to communicate between parties.

26. As per claim 8, Thro et al. teach wherein the data is dictated by each rule in the relevant recipient party entry for the initiating party requesting to communicate – fig. 2, elements 74-86; col. 3, line 48 to col. 4, line 66.

27. As per claim 9, Thro et al. do not explicitly suggest “wherein a security mechanism is provided for secure access by a recipient party to their entry.” However, Swartz teach “wherein a security mechanism is provided for secure access by a recipient party to their entry.” – col. 6, lines 20-57. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the applicants’ teaching with Swartz’s teaching of secure access in order to better protect the communication system from unauthorized accesses of web enabled devices.

### ***Response to Arguments***

Applicant's arguments filed 6/7/05 have been fully considered but they are not persuasive. In response to Applicants’ argument that Thro does not disclose “the server generates data which results in the automatic opening of a communication application” on page 6, Examiner finds that Thro does teach based on the priority level and

recipients' selections of how messages would be displayed such as a page or voice, messages are displayed to recipients accordingly – col. 4, line 13 to col. 5, line 25. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., an email package such as Outlook) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). However, one question raised is if recipients' devices are not active, how can any applications be initiated.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

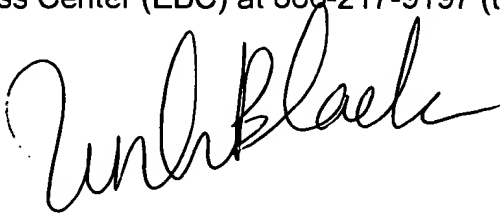
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LINH BLACK whose telephone number is 571-272-4106. The examiner can normally be reached on 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN BREENE can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



LINH BLACK  
Examiner  
Art Unit 2167

August 22, 2005



GRETA ROBINSON  
PRIMARY EXAMINER